



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/507,093	02/17/2000	Hyung-sik Choi	YPLA0002	7685

7590
J.C. PATENTS
Suite 250
4 Venture
Irvine, CA 92618

06/04/2003

EXAMINER

KEMPER, MELANIE A

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 06/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/507,093

Applicant(s)

CHOI, HYUNG-SIK

Examiner

M Kemper

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3-5-03 has been entered.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3,5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horstmann, patent number 6,285,985 in view of Petrecca et al., patent number 5,781,894.

Horstmann teaches an advertising method using software products comprising: making the software program stop in operation during the use of the software program when the advertisement is displayed (col. 3, lines 53-56, col. 4, lines 35-40). Horstmann also teaches accessing the web site of the sponsor by clicking on the web site address (col. 4, lines 10-20); and an advertisement window exists as another open window on the display (col. 4, lines 35-40, col. 3, lines 50-55). While Horstmann does not specifically state that the software program resumes only when the sponsored advertisement is

Art Unit: 3622

clicked on, it would have been obvious to one having ordinary skill in the art to have allowed the program to resume by clicking on the advertisement since this would have been adopted for the intended use of allowing the user to regain control over the use of the application and increasing user satisfaction with the subsidized software while still monitoring that ads are viewed by the user for the sponsors. It also would have been obvious to have downloaded the program since this is well known in the art for convenience in obtaining software and for obtaining software updates (upgrades).

Petrecca teaches an advertising method using software products in which at least one advertisement is inserted comprising: inserting at least one advertisement into at least one portion of the software program during the making of the software (col. 2, lines 40-60, col. 3, lines 20-35); wherein the software program with the inserted advertisement is reproducible and operable without connecting to the Internet (col. 1, lines 55-57, col. 2, lines 50-56) and where the program is free or at low cost (col. 2, lines 15-40). It would have been obvious to one having ordinary skill in the art at the time of the invention to have the software program with the inserted advertisement operable without connecting to the Internet as in Petrecca in the system of Horstmann since this would have allowed sponsors to reach more customers by providing another software distribution channel (disks). While Petrecca does not specifically state that the program is reproducible, it would have been obvious to one having ordinary skill in the art at the time of the invention to have allowed users to copy the program since this would have reached more potential buyers. Alternatively, it would have been obvious to one having ordinary skill in the art at the time of the invention to have made the program

Art Unit: 3622

stop operation to display the advertisement and resumed the program when the advertisement is clicked on as in Horstmann since this would have been adopted for the intended use of forcing the user to pay attention to the advertisement(s).

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rosen et al., patent number 5,995,102 teaches resuming the software program only when the user clicks on the advertisement (col. 2, lines 5-25). Donohue, patent number 6,202,207 teaches downloading low cost software (col. 1, line 60 – col. 2, line 15). Slivka et al., patent number 6,256,668 also teaches downloading free software (abstract).

5. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

6. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the


Art Unit: 3622

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M Kemper whose telephone number is 703-305-9589. The examiner can normally be reached on M-F (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.


M Kemper
Primary Examiner
Art Unit 3622

mk
June 2, 2003